UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,667	04/22/2004	Arnold Thaler	74104.105017	6830

86528 7590 03/28/2011

King & Spalding LLP
401 Congress Avenue
Suite 3200
Austin, TX 78701

EXAMINER	
REAGAN, JAMES A	
ART UNIT	PAPER NUMBER
3621	

NOTIFICATION DATE	DELIVERY MODE
03/28/2011	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

AustinUSPTO@kslaw.com
AustinIP@kslaw.com

Office Action Summary	Application No.	Applicant(s)	
	10/829,667	THALER, ARNOLD	
	Examiner	Art Unit	
	JAMES A. REAGAN	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 July 2010*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20,38-42 and 48-50* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20,38-42 and 48-50* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *22 April 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgments

1. This action is in reply to the RCE, amendment, and response filed on **07/15/2010**.
2. Claims 1 and 50 have been amended.
3. Claims 1-20, 38-42, and 48-50 are currently pending and have been examined.

Response to Arguments

4. Applicant's arguments received **07/15/2010** have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.

5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claims 1 and 50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner cannot determine the metes and bounds of the claim because the claim has been written in the alternative using an "or" statement. For the purposes of this examination, the Examiner will assume that the claim is a properly written Markush-type limitation: *...one of the group consisting of [A, B,* ***and*** *C].*

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 1-20, 38-42 and 48-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alicot et al. (US 6,429,776 B1), hereinafter **ALICOT**, in view of Ronchi et al. (USPGP 2002/0077973 A1), hereinafter **RONCHI**.

Claim 1:

ALICOT as shown below discloses the following limitations:

- *a product configured to perform electronic functions, the product having electronic control circuits* (see at least abstract; col. 2, lines 20-31);

ALICOT does not disclose the following limitations, but **RONCHI** as shown does:

- *a verification and activation module configured to be removably or permanently coupled, or remain removably or permanently coupled, to the electronic control circuits of the product after a purchase of the product;* (see at least paragraphs 0003, 0008, 0035)
- *wherein the verification and activation module is configured for facilitating the activation of the electronic control circuits of the product such that the electronic functions of the product become enabled;* (see at least paragraph 0008)
- *wherein the verification and activation module includes a memory configured to receive and store data during a purchase of the product, such that the data received and stored during the purchase of the product remains removably or permanently stored in the product after the purchase of the product.* (see at least paragraph 0014)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the RFID tag and reader assembly of **ALICOT** with the activations and validation technique of **RONCHI** because In the competitive business climate, there is a profit-driven motive to maximize the profitability of goods and services that are provided or marketed to customers. Enterprises typically use business planning to make decisions in order to maximize profits. Furthermore, "A wireless communication

transponder, for example a radio frequency identification (RFID) tag, can provide the ability to store and update information within an internal storage element and can be associated with a product starting at its manufacturing origins. This transponder can be used and reused throughout manufacturing, distribution and the retail processing of the product. These transponders are already provided with EAS elements, and are further able to store encoded bar code information. At a point of sale (POS), for example, the transponder can be scanned to retrieve the stored information. However, a bar-code scanner can be present, and indeed is likely to be present, which interfaces to the cash register and the retail system. An item or product needs to be scanned by the bar code reader as well, to complete a transaction." (**ALICOT**: Column 1, lines 20-35)

Claim 2:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the verification and activation module is removably coupled to the product* (see at least col. 2, lines 32-55; col. 5, lines 21-41).

Claim 3:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the control circuits of the product are deactivated when the verification and activation module is not coupled to the product* (see at least col. 4, lines 13-38).

Claim 4:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the verification and activation module is programmed with information* (see at least col. 2, lines 32-55; col. 5, lines 21-41).

Claim 5:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the programmed information comprises purchase date and price of the product* (see at least col. 4, lines 1-12).

Claim 6:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the programmed information comprises warranty information for the product* (see at least col. 3, lines 21-35; col. 4, lines 1-12).

Claim 7:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the programmed information comprises data about a consumer who purchased the product* (see at least abstract).

Claim 8:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the programmed information comprises data about a manufacturer of the product* (see at least col. 2, lines 32-55; col. 5, lines 21-41).

Claim 9:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the programmed information comprises data about the product* (see at least col. 2, lines 32-55; col. 5, lines 21-41).

Claim 10:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the verification and activation module comprises a non-volatile programmable memory* (see at least abstract).

Claim 11:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the non-volatile memory is selected from the group consisting of electrically erasable and programmable read only memory (EEPROM), Flash memory and battery backed-up random access memory (RAM)* (see at least abstract; col. 2, lines 32-55).

Claim 12:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the product comprises verification and activation circuits* (see at least col. 4, lines 39-55).

Claim 13:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the verification and activation module comprises a non-volatile programmable memory, and verification and activation circuits* (see at least col. 4, lines 39-55).

Claim 14:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *a security feature that deactivates the product when outside of a geographical location* (see at least col. 4, lines 13-38).

Claim 15:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *a security feature that deactivates the product when a security signal is not present* (see at least col. 4, lines 13-38).

Claim 16:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *warranty history of the product is stored in the non-volatile memory* (see at least col. 3, lines 21-35; col. 4, lines 1-12).

Claim 17:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *repair history of the product is stored in the non-volatile memory* (see at least col. 3, lines 21-35; col. 4, lines 1-12).

Claim 18:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *maintenance history of the product is stored in the non-volatile memory* (see at least abstract; col. 3, lines 21-35; col. 4, lines 1-12).

Claim 19:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *a communications interface coupled to the verification and activation module* (see at least col. 4, lines 13-38).

Claim 20:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the communications interface is selected from the group consisting of WIFI and Bluetooth* (see at least col. 5, lines 21-40).

Claim 38:

ALICOT as shown below discloses the following limitations:

- *a product configured to perform electronic functions, the product having electronic control circuits* (see at least abstract; col. 2, lines 20-31); *an original product configured for electronic operation* (see abstract;

ALICOT does not disclose the following limitations, but **RONCHI** as shown does:

- *a verification and activation module coupled to the original product* (see at least paragraphs 0003, 0008, 0035)
- *a replacement product configured for electronic operation, wherein when the verification and activation module is removed from the original product and coupled to the replacement product, the electronic operation of the replacement product is enabled and the electronic operation of the original product is disabled* (see at least paragraphs 0003, 0008, 0033, 0035)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine/modify the RFID tag and reader assembly of **ALICOT** with the activations and validation technique of **RONCHI** because In the competitive business climate, there is a profit-driven motive to maximize the profitability of goods and services that are provided or marketed to customers. Enterprises typically use business planning to make decisions in order to maximize profits. Furthermore, "A wireless communication transponder, for example a radio frequency identification (RFID) tag, can provide the ability to store and update information within an internal storage element and can be associated with a product starting at its manufacturing origins. This transponder can be

used and reused throughout manufacturing, distribution and the retail processing of the product. These transponders are already provided with EAS elements, and are further able to store encoded bar code information. At a point of sale (POS), for example, the transponder can be scanned to retrieve the stored information. However, a bar-code scanner can be present, and indeed is likely to be present, which interfaces to the cash register and the retail system. An item or product needs to be scanned by the bar code reader as well, to complete a transaction." (**ALICOT**: Column 1, lines 20-35)

Claim 39:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *once the replacement product has been enabled for operation by the verification and activation module, the original product cannot be enabled again by the verification and activation module* (see at least col. 2, lines 32-55; col. 5, lines 21-41).

Claim 41:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses *the communication is wireless.* (see at least col. 5, lines 21-40).

Claim 42:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections above. **ALICOT** further discloses the communication is by wire (see col. 2, lines 32-55; col. 5, lines 21-41).

Claims 40 and 48-50:

The combination of **ALICOT/RONCHI** discloses the limitations as shown in the rejections of the claims above. The Examiner finds that remaining claims 40, and 48-50 are not patentably distinct from claims 1-20, 38, 39, 41, and 42, nor do they produce any new, meaningful, synergetic result that would render the claims novel and therefore, for the sake of clarity, has grouped the rejections of claims 1-20, 38-42 and 48-50 accordingly using the same references and citations as above.

CONCLUSION

13. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **James A. Reagan** (james.reagan@uspto.gov) whose telephone number is **571.272.6710.** The Examiner can normally be reached on Monday-Friday, 9:30am-5:00pm. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **ANDREW J. FISCHER** can be reached at **571.272.6779**.

14. Should Applicant desire in the future to receive formal or informal email communications from the Examiner (e.g. acknowledgments, references, courtesy copies of documents, etc.), the electronic file must contain written authorization to conduct email communications. See MPEP §502.03 III. For Applicant's benefit, exemplary language for written authorization is in MPEP §502.03 III. ¶4. The exemplary language is:

> ***Recognizing that Internet communications are not secure, I hereby authorize the USPTO to communicate with me concerning any subject matter of this application by electronic mail. I understand that a copy of these communications will be made of record in the application file.***

15. In the situation where Applicant desires to receive email communications from the Examiner, the Examiner suggests placing the above exemplary language in Applicant's next correspondence.

16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair . Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

17. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **571-273-8300**.

18. Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/James A. Reagan/
Primary Examiner, Art Unit 3621
james.reagan@uspto.gov
571.272.6710 (Office)
571.273.6710 (Desktop Fax)